

Application No. 09/733,016
Reply Brief dated July 21, 2003
Attorney Docket No. 2384-002134

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. : 09/733,016
Applicant : Andrea Michalik
Filed : December 8, 2000
Title : **GERANIUM PLANT NAMED
'PENNEA'**
Group Art Unit : 1661
Examiner : Kent L. Bell

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer dated May 20, 2003.

I. Factual Background

The above-identified plant patent application was filed with the United States Patent and Trademark Office for a variety of geranium named 'Pennea' on December 8, 2000. A variety of geranium named 'Pennea' was sold in Europe in July of 1998. An application for a Community Plant Variety Rights (hereinafter, "CPVR") Certificate/Plant Breeders Rights (hereinafter, "PBR") Certificate was filed with the Community Plant Variety Office (hereinafter, "CPVO") in Europe for 'Pennea' on February 25, 1998 and given the reference number EU 98/0251. On April 15, 1998, the CPVO published a listing of

#116
8/8/03
JUL 28 2003
TECHNICAL 1600/2900
RECEIVED

application EU 98/0251 in the Official Gazette with minimal non-enabling botanical information.

Claim 1 stands rejected under 35 U.S.C. § 102(b) for asserted anticipation by EU 98/0251 in view of a sale of a variety of geranium named 'Pennea' outside the United States in 1998.

II. The issue on Appeal in the present application is whether a non-enabling printed publication on a plant variety rises to the level of enabling prior art when the plant was sold outside the United States.

The plant patent examining group has created a new position on prior art to plant patent applications that is counter to decades of examination. This position has no basis in fact or in law and is based in part on a false premise, namely, LeGrice did not deal with sale in a foreign country. This policy, if not reversed by the Board, will have the effect of essentially blocking United States plant patents on plant varieties discovered in foreign countries. It represents the ultimate disservice to the foreign breeder.

A plant variety discovered in a foreign country typically requires several years of testing in the foreign market before it is selected for introduction in the United States. It also needs field trialing in the United States to determine if it can grow in the varied climatic conditions of this country. During that time, an application for PBR may be filed in that country and the variety may be sold into the foreign market. Neither of those activities (an application for PBR on the variety or a sale of the variety outside the United States) have previously been considered enabling prior art.

The sale puts the variety in a public domain, but not the public domain which constitutes a statutory bar - it is not "in this country" as required by 35 U.S.C. § 102(b).

The effects of this examination policy of using the foreign sale of a variety to enable a printed publication on the variety are several and at least include the following:

- (1) Countless extent plant patents would be invalid.
- (2) Foreign plant breeders must rush to file United States patent applications, even before foreign testing is complete, on all potential

varieties. This is a financial disaster where normally 10% or less of the varieties tested are ultimately introduced into the United States market.

- (3) Foreign-bred plants may never reach the United States because foreign plant breeders have no incentive (no protection) for their varieties subject to the present examination policy.

This Appeal was instigated to avoid these effects and to permit Applicant to protect his rights in the United States.

III. The board should follow the holding of *In re LeGrice* (a plant patent decision), not that of *In re Thomson* (a utility patent decision)

The arguments and issue presented by the Applicant in the plant patent examining group, not repeated herein, actually boil down to a basic question. Should the Board follow the precedent of *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). The answer is YES.

A. *LeGrice* answered the same question posed in this Appeal.

At issue in *LeGrice* was whether a printed publication regarding a plant variety, when interpreted in light of the knowledge possessed by plant breeders, is capable of placing that variety in the public domain to constitute a bar under 35 U.S.C. § 102(b).

In the present case, the Examiner has asserted that *LeGrice* is not controlling because it did not specifically address the issue of enablement of a printed publication on a plant variety by sale of that plant outside the United States. However, as detailed below, the appeal in *LeGrice* actually did address an issue of commercial availability of a plant outside the United States.

B. The *LeGrice* decision contains significant evidence of public distribution of the rose varieties.

The Appellant of *LeGrice*, (Mr. Edward Burton LeGrice) filed plant patent applications in the United States in 1958 on two rose varieties, Charming Maid and Duskey Maiden. More than one year before the filing dates, both varieties were listed in the National

Rose Society Annual of England and in catalogs. Those publications are compelling evidence of public use or sale of the varieties in England.

The Rose Annual of 1949 stated that Dusky Maiden, "raised and exhibited by E.B. LeGrice", received "The Gold Medal Award". *Id.* at 931, 133 USPQ at 368. An award-winning plant undoubtedly was exhibited to rose breeders and other skilled artisans. Certainly, Dusky Maiden was publicly used in England by 1949.

The Rose Annual of 1954 contained information on Charming Maid including listing the following: "Raiser and Distributor E.B. LeGrice, Note Walsham". *Id.* at 932, USPQ at 368. According to the 1954 Rose Annual, Charming Maid was distributed by Mr. LeGrice. Distribution (via a sale or other public activity) of Charming Maid occurred in England more than one year before the United States filing date.

Both Dusky Maiden and Charming Maid were described and shown in catalogs with color photographs thereof establishing identity in appearance between the varieties in the catalogs and the varieties of the United States plant patent applications. *Id.* Presentations of the varieties in a catalog is also compelling evidence of their status of having been offered for sale in England.

Despite all this evidence of sale and/or public use of Dusky Maiden and Charming Maid by Mr. LeGrice in England, the appeals court did not specifically address any issue of such activity presumably because it occurred outside the United States.

C. The record of the appeal in *LeGrice* shows that the sale and/or public use of the two rose varieties was disposed by the Board.

There was no discussion about enablement of the printed publication based on public availability of the rose in the *LeGrice* decision reported by the CCPA because the issue of public availability of the roses outside the United States was disposed of in the lower decision at the Board of Appeals. *Application of Edward Burton LeGrice*, Decision of Board of Appeals, February 12, 1960 (previously submitted with Applicant's Appeal Brief and hereinafter referred to as the "Board LeGrice Decision").

In the appeal to the Board by Mr. LeGrice, the Board correctly recognized that the “use or sale of the plants in a foreign country would be irrelevant” to the issue of novelty. *Id.* at page 25. Moreover, the Board found evidence of foreign sale and/or public use of the rose varieties.

The publications indicated that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as 'raiser and distributor.' However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

Id. at page 22.

Hence, the *LeGrice* court had plenty of evidence of commercial availability of the rose varieties outside the United States, and the stated presumption was that the plant was in public use. It did not directly address those facts since they were irrelevant to the novelty of the plant under United States statutory law and had been properly dispensed with by the Board of Appeals.

D. A publication is incapable of placing a plant variety in the public domain.

The *LeGrice* court focused on whether the publications (the Rose Annuals or the catalogs), when interpreted in light of the knowledge possessed by plant breeders, placed the rose varieties in the public domain. Importantly, when the court looked to what constituted the knowledge possessed by plant breeders, it did not even consider the evidence of prior use and/or sale of the rose varieties. The Board had dismissed any relevance of that evidence to the issue of novelty of the rose varieties in the United States.

Instead, the standard applied by the *LeGrice* court for the enablement of a publication under 35 U.S.C. § 102(b) is whether “a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the

invention". *LeGrice* at 936, 133 USPQ at 372. The "knowledge" for a skilled artisan was not -- and still is not -- the commercial activity of the breeder outside the United States.

The "knowledge" of the skilled plant breeder includes plant genetics. In 1962, the knowledge of plant genetics meant that publications (such as the *Rose Annuals* and catalogs) could not be relied upon as statutory bars under 35 U.S.C. § 102(b). The *LeGrice* court cautioned, however, that each case must be decided on its own facts and that future studies may add to "the knowledge of plant breeders so that they may *someday* secure possession of a plant invention by a description in a printed publication". *Id.* at 939, n. 7, 133 USPQ at 374, n. 7.

There can be no dispute; that "someday" has not yet arrived.

IV. *Ex parte Thomson* does not control the enablement of prior art in plant patent applications.

In *Ex parte Thomson*, 24 USPQ 2d 1618 (Bd. Pat. App. & Int. 1992), the applicant appealed the rejection for lack of novelty in a utility patent application claiming asexually reproduced plant and seeds thereof. At issue, as in *LeGrice*, was whether a skilled artisan would have had sufficient knowledge to make the invention (the plant) described in a publication.

The Board looked to the opportunity to buy the seeds outside the United States as being the wherewithal of the skilled plant grower to obtain the claimed invention. Without citing to precedent, the Board raised the foreign sale of the seeds from a nonstatutory bar to an enablement of the publication.

In other words, the foreign sale of seeds became a reference, a point of knowledge, for the skilled artisan.

A. Sale of patentable subject matter outside of the United States is not prior art and cannot be used to enable a reference under 35 U.S.C. § 102(b).

Relying on *Thomson*, the Examiner's Answer asserts that a non-enabling publication listing a plant variety, combined with evidence of the sale of that variety outside

the United States, is an appropriate anticipation rejection. The Examiner's Answer also argues that the language in *In re Samour*, 571 F.2d 559, 562, 197 USPQ 4 (CCPA 1978), of "[w]hether the claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art." means that any public information relating to the claimed invention becomes an additional reference to enable a reference.

However, as was noted in Appellant's Appeal Brief, *Samour* stands for the premise that an additional written reference may be relied upon to show what the primary reference contains. The additional written reference may be relied upon to show that the information contained in the primary reference, by itself, is fully enabling to one skilled in the art. *Samour* does not stand for the premise that an additional reference may be used to supplement the primary reference when the primary reference alone is not fully enabling.

The Examiner's Answer also misinterprets *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). The *Donohue* case stands for the proposition that additional written references may be used to show that the claimed subject matter was in the public's possession before application thereof for a patent. The public disclosure of a chemical compound and the public disclosure of the name and variety of an asexually reproduced plant are two distinct situations. As the *Donohue* court stated, "[i]t is elementary that an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device." *Id.* at 534, 226 USPQ at 621.

It is elementary chemistry to realize that the disclosure of a compound's formula is enough to anticipate the claimed chemical formula because that formula is indeed the entire invention. However, disclosure of the botanical name (and possibly a few other particulars) of a new and unanticipated asexually reproduced plant variety is not enough to anticipate a plant patent for the claimed variety. As in *Samour*, the *Donohue* court agreed that a secondary piece of prior art (a written publication) could be used to show that knowledge was in the public's possession. In both cases, the secondary references (printed publications) provided information on the state of the art in the chemical field.

The Examiner's Answer on one hand asserts that the sale of a variety named 'Pennea' in Europe is not used as "supplementing" reference yet on the other hand supports the position for looking to the sale in Europe to enable the CPVO publication by relying on *Samour* and *Donohue*. Both cases allowed an additional piece of prior art (a pre-application filing date publication) as evidence of what knowledge was in the public domain.

However, it is contrary to longstanding tenets of the patent laws to assert that sale of a claimed invention outside of the United States qualifies as a reference at all. The sale of a variety named 'Pennea' outside the United States is not prior art. It is not a reference which is appropriate to use as evidence of the public's knowledge. An assertion that the sale of a claimed invention outside the United States is a reference (per *Samour* and *Donohue*) would vitiate the meaning of the on-sale bar of 35 U.S.C. § 102(b).

If the Board agrees with Examiner, it would be changing the landscape of the patent law. Applicant appreciates the Examiner's recognition that the PBR publication by itself would not be an enabled publication. In essence, the Examiner is asserting that a non-enabling published description of a claimed invention combined with the sale of that invention outside of the United States would be enough to satisfy an anticipation rejection under 35 USC § 102(b).

Such a position is untenable under United States law. By way of example, a simple (non-enabling) listing of a product (such as a computer) in a catalog or magazine published one year before an application for patent in the United States combined with the sale of that product outside the United States more than one year before application date would be enough to bar patent protection in our country. Such an assertion is ludicrous and the ramifications are endless if the Board chooses to change precedent and decide that the cited PBR application combined with the sale of a geranium named 'Pennea' in Europe would be enough to bar patent protection in the United States.

B. Even if *Thomson* is good law for utility applications, it is distinguishable from the present case.

The Board in *Thomson* chose to not follow *LeGrice* for the following reasons (however errant):

- (1) Per *LeGrice*, each case is decided on its own facts. Supposedly, in the day of *Thomson* in 1992, unlike in the day of *LeGrice*, the “someday” of plant genetics had arrived.
- (2) *LeGrice* lacked evidence of commercial availability of the claimed invention outside the United States.
- (3) *LeGrice* concerned a plant patent while *Thomson* dealt with a utility patent with broader scope of protection.

The first point fails because the “someday” of plant genetics is not here; see the Declaration of Dr. Richard Craig where he concludes that “Starting only from a photograph or a written description of a particular cultivar, a plant breeder cannot reproduce the cultivar. No person can independently create through fertilization and hybridization the exact genetic replica of another plant.” Craig Declaration at page 4. The Examiner admits the same, else the PBR application would alone be cited as barring a plant patent. However, a key part of the first point is that these cases (*LeGrice* and *Thomson*) are decided on their own facts.

The second point fails because the Board misunderstood the evidence of commercial availability of the rose varieties in *LeGrice* by stating that:

[*LeGrice*’s] holding was based on the specific “printed publications” before it, and no indication was given that the “prior catalogue publication” before it evidenced commercial availability in a readily enabling form. The court simply stated that the prior catalog publication “includes a color picture of the rose clear enough to establish identity in appearance between the rose illustrated and applicants variety”.

Thomson, 24 USPQ2d at 1621.

As detailed above, the *LeGrice* decision is replete with evidence of public use and/or sale of the rose varieties outside the United States. The irrelevance of those activities was disposed of by the Board.

The third point simply cuts in favor of following *LeGrice*. The present case is factually very similar to *LeGrice* and, unlike the utility application appealed in *Thomson*, involved a plant patent application.

V. Conclusion

The “someday” of plant genetics from *LeGrice* has not arrived. A printed publication cannot bar patenting of a plant because a plant variety cannot be created from a description of the plant.

The only § 102(b) bar to plant patent applications is the sale, offer for sale, or public use of the plant itself within the United States. Likewise, the invention of a plant patent is the plant itself. A plant patent can have but one claim -- to the plant itself. Plant patent infringement requires proof that the infringing plant is an asexually reproduced progeny of the parent plant -- it requires access to the plant itself. *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 36 USPQ2d 1673 (Fed. Cir. 1995).

It follows that the plant itself must be present in the United States to bar novelty under §102(b). The asserted enablement of a printed publication by “non-prior art” (sale outside the United States) is an attempt to thwart the statutory requirement that the plant itself be present in the United States to bar a plant patent in light of today’s understanding of plant genetics.

Applicant urges the Board to follow the established federal court precedent of *LeGrice* and reverse the novelty rejection in the present application.

Application No. 09/733,016
Reply Brief dated July 21, 2003
Attorney Docket No. 2384-002134

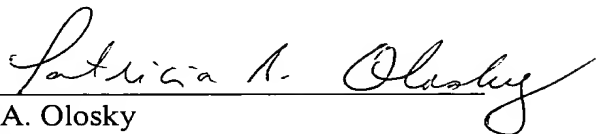
The Commissioner for Patents is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

Date: July 21, 2003

By



Patricia A. Olosky
Registration No. 53,411
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219-1818
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com



AF
1661

ATTORNEY DOCKET NO.: 2384-002134

REPLY BRIEF TRANSMITTAL LETTER

MAIL STOP APPEAL BRIEF – PATENTS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Serial No.: 09/733,016 Filing Date: December 8, 2000

Examiner: Kent L. Bell Group Art Unit: 1661

Title: GERANIUM PLANT NAMED 'PENNEA'

Transmitted herewith is a Reply Brief in the above-identified application.

- ☐ Small Entity Status is asserted for this application under 37 CFR 1.27.
☐ A verified statement to establish small entity status under 37 CFR 1.27 is enclosed.
☒ No additional fee is required.
☐ The fee has been calculated as shown below:

| No of Claims After Amendment | Highest No. Previously Paid For | Present Entity Extra | Small Entity Rate | Non-Small Entity Rate | Charge |
|--|---------------------------------------|-------------------------|-------------------------|-----------------------------|--------|
| Total 1 | 20 | 0 | x \$ 9.00 | x \$ 18.00 | \$ 0 |
| Indep. 1 | 3 | 0 | x \$ 42.00 | x \$ 84.00 | \$ 0 |
| First Presentation of Multiple Dependent Claim/s | | | + \$140.00 | + \$280.00 | \$ 0 |
| TOTAL ADDITIONAL FEE | | | | | \$ 0 |

- ☐ A check in the amount of \$_____ is enclosed to cover the filing fee.
☐ Checks in the amounts of \$_____ to cover the Reply Brief fee and \$_____ to cover the Request for Oral Hearing fee are enclosed
☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650. An original and two copies of this Transmittal are enclosed.
☒ Any additional filing fees required under 37 CFR 1.16.
☒ Any patent application processing fees under 37 CFR 1.17.

July 21, 2003

Date

By

Patricia A. Olosky
Registration No. 53,411
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on July 21, 2003.

Theresa Ulinski

(Typed Name of Person Mailing Paper and/or Fees)

Signature

Date